



\$AR

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

DSGN:002US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on May 22, 2006

Signature

Typed or printed name

Mark T. Garrett

Application Number

09/823,909

Filed

March 29, 2001

First Named Inventor

Masasuke Kawasaki

Art Unit

3673

Examiner

Singh, S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 44,699

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Mark T. Garrett

Typed or printed name

(512) 536-3031

Telephone number

May 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



## Arguments in Support of Pre-Appeal Brief Request for Review for 09/823,909

### The Anticipation Rejection of Independent Claims 85 and 86 Are Without Factual Support

Claim 85 is directed to a system useful in stabilizing a vessel. The vessel includes a first leg, a second leg, a third leg, and a platform coupled to the first, second, and third legs such that the platform may be raised or lowered along the first, second and third legs. The system comprises a brace coupled to each leg such that each brace forms an acute angle with the leg to which it is coupled and a least a portion of each brace is located directly beneath the platform; and an anchoring structure coupled to each brace. Each anchoring structure is configured to tension the brace to which it is coupled such that *each brace can be tensioned independently of the other braces*.

The Office does not address the independent tensioning configuration of each anchoring structure in the rejection on page 2 of the 2006 Action. In the “Response to Arguments” section of the Action on page 8, the Office states that “each brace can be tensioned independently since brace (8,9) and (20,25) each have their own respective hydraulic jacks[.]” This is not correct. Braces 8 and 9 are each coupled to the platform 1 with a chain stopper 12, not a hydraulic jack. Brace 20 is not connected to a hydraulic jack either; it is connected to left leg 2 at either location 26 or location 27. As for brace 25, the pressure cylinders 7 which the British Application discloses are connected between the upper part 6 and lower part 5 of each climbing and locking mechanism 4. Thus, while those pressure cylinders might play a role in adjusting the distance between the upper and lower parts of the climbing and locking mechanism 4, there is no teaching or suggestion that the pressure cylinders play any role in any tensioning of brace 25.

Furthermore, the British Application states that the braces are always tensioned together by raising the platform “a little bit upwardly” or “a little bit downwardly.” *See* page 1, lines 105-

111, claim 8 and Abstract; *see also* Applicants' arguments on pages 17 and 18 of the last Response. Thus, anticipation has not been established for claim 85 and the rejection should be withdrawn.

The anticipation rejection of claim 86, which is a method claim, should be removed for the same reason as the anticipation rejection of system claim 85.

## **II. The Obviousness Rejection of Independent Claim 66 Is Without Factual Support**

The Office admits that the British Application is silent about lifting a leg that shifts horizontally as recited in independent claim 66, but claims it would have been obvious "to modify British document by lifting a leg that shifts horizontally since the tensioning means disclosed by British document affords this. The reason for doing so would be to ensure that he (sic) platform and (sic) move up and down." 2006 Action at page 3. Applicants do not understand what motivation the Office is asserting. *See* MPEP § 707.07(d) ("Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and *clearly* stated . . .") (emphasis added). Moreover, there is no factual support for the Office's assertion. As the Federal Circuit explained in *Zurko*:

With respect to **core factual findings** in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

*In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added); MPEP § 2144.03 ("It is never appropriate to rely **solely** on common knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.") (citing *In re Zurko*, 258 F.3d at 1386). The rejection should be withdrawn.

### **III. The Obviousness Rejection of Independent Claim 84 Is Without Factual Support**

Claim 84 is directed to a vessel. The vessel includes a platform; three legs coupled to the platform such that the platform may be raised or lowered along the three legs; a footing structure coupled to an end of one of the legs; and a flexible brace coupled at two different locations to the leg with the footing structure. The flexible brace forms an acute angle with that leg. One of the two claimed locations is on the footing structure. As an example of this, see brace 30 which is coupled as claimed to leg 14 in FIG. 32 of the present application.

The Office admitted that the British Application “is silent about the brace being coupled at two different locations on the footing structure.” 2006 Action at page 3. While this is true, the claim recites a flexible brace coupled at two different locations, *one* of which is on the footing structure (not necessarily *both* as stated by the Office). The Office then asserts that “Ward, Jr. teaches a brace being coupled at two different locations on a footing structure (see Figs. 5,8).” Again, the Office is mischaracterizing the claim. Moreover, the Office is wrong about Ward’s teachings. Neither FIG. 5 nor FIG. 8 of Ward (US 3,093,972) show a *flexible* brace coupled at two different locations to a single leg to which a footing structure is coupled, where one of the locations is on the footing structure. In fact, FIG. 5 shows neither a flexible brace nor a footing structure. The rejection should be withdrawn.

### **IV. The Obviousness Rejection of Independent Claim 1 Is Without Factual Support**

The basis for the patentability over the references cited in combination against claim 1 is set forth on pages 19-21 of the August 2005 Response, including the cited portion of the Kawasaki Declaration. In essence, the British Application teaches *away from* loading reversing wheel 22 or using it to tension a line, which is what the Office is suggesting where it advocates replacing reversing wheel 22 with a winch configured to maintain tension in cable 20.

Furthermore, the Office fails to clearly address the claim limitation that the claimed winch motor is *synchronized* with the one or more motors that can drive pinions to raise or lower the platform along the legs such that tension in the claimed first brace is maintained with the winch motor while raising or lowering the platform. The Office states that the British Application teaches “synchronizing movement of the platform with tensioning of the brace (see Abstract)” (2006 Action at p. 4), but does not state what the motivation is for replacing the tensioning mechanism in the British Application (which is moving the platform up and down, as the Abstract states; thus, this replacement *eliminates* the *synchronizing movement* on which the Office relies) with a winch motor, modifying the British Application so that platform movement can be achieved using one or more motors to drive pinions, and then *synchronizing* the winch motor with the one or more pinion-driving motors. For these reasons, the rejection of claim 1 and its rejected dependent claims (including claim 3) should be withdrawn.

**V. The Obviousness Rejection of Independent Claim 40 Is Without Factual Support**

The Office’s obviousness rejection of claims 40, 41 and 43-51 is without factual support and should be withdrawn for the reasons stated on pages 24 and 25 of the August 2005 Response, including the cited portion of the Kawasaki Declaration.

**VI. The Obviousness Rejection of Dependent Claim 42 Is Without Factual Support**

The Office’s obviousness rejection of dependent claim 42 is without factual support and should be withdrawn for the reasons stated on pages 26 of the August 2005 Response.

**VII. The Obviousness Rejection of Independent Claim 54 Is Without Factual Support**

The Office’s obviousness rejection of claims 54, 55, 70 and 71 is without factual support and should be withdrawn for the reasons stated on pages 26 – 28 of the August 2005 Response, including the cited portion of the Kawasaki Declaration.